

REMARKS

Claims 1 through 45 are pending in this application.

Requirement for Restriction under 37 C.F.R. §1.141

In Paper No. 7, the Examiner required Applicant pursuant to 35 U.S.C. §121 and 37 C.F.R. §1.141, to elect between:

I. Claims 1-11, 13, 30-45, drawn to a shadow mask with the first slot group having wider interval between the bridges than the second slot group, classified in class 313, subclass 407;

II. Claim 12, drawn to a shadow mask wherein a portion where the bridges are formed and a portion where the bridges are not formed are alternately disposed in a horizontal direction, classified in class 313, subclass 402; and

III. Claims 14-29, drawn to a method of assembling a shadow mask classified in class 445, subclass 30.

The Examiner states that a telephone call was made to Mr. Robert E. Bushnell on February 10, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made. However, we have no record of such a conversation.

The Applicant provisionally elects, with traverse, Group I (Claims 1-11, 13, 30-45).

Claims 1-45 all define the subject matter of elected Group I. Accordingly, examination of all pending claims is required.

Applicant traverses the requirement and requests re-consideration and withdrawal of the

requirement, because all patents and patent applications directed to the subject matter of any of Group I, Group II, or Group III by statute, must necessarily disclose out to make and use the subject matter disclosed by those patents and patent applications. Consequently, the mandatory field of search for Group I, II and III are co-extensive and inherently overlapping in their disclosed details. A search confined to solely one class, without considering the classes directed to other statutory matter, is intrinsically incomplete. Consequently, the Examiner must search the designated subclasses of both class 313 and class 445. Withdrawal of the requirement is therefore requested.

As specifically stated in MPEP § 803, the examiner must show that (A) The inventions must be independent (see MEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); **and** (B) There must be a **serious burden** on the examiner if restriction is required (see MPEP §803.02, § 806.04(a) -§806.04(i),§808.01(a), and § 808.02).

The Examiner reasons that in the instant case the different inventions have different modes of operation, different effects and different functions and because these inventions are distinct for these reasons and because the search required for one Group is not required for another Group and so restriction for examination purposes as indicated is proper. Therefore, the Examiner reasons that because these inventions are distinct and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

However, proof of “different inventions have different modes of operation, different effects and different functions” is very generalized and fails in the Examiner’s burden of showing that the inventions are independent or distinct

Furthermore, the reasoning of “the search required for one Group is not required for another Group and so restriction for examination purposes as indicated is proper” is not the standard set by the MPEP. As mentioned above, in the MPEP, there must be a serious burden on the examiner if restriction is required (see MPEP §803.02, § 806.04(a) -§806.04(i), §808.01(a), and § 808.02) and not just merely that search required for one group is not required for another. A complete search must be done, and in that regard, all classifications must be looked at especially since certain features in one group are also in another.

As stipulated in *MPEP* §803, if the search can be made without serious burden, the Examiner must examine it on the merits even if there are separate and distinct inventions. It is respectfully submitted that there would not be a serious burden upon the examiner.

First there are limitations in common in each of the groups as seen in claims 1 through 45. For example dependent claim 40 in group I, encompasses the subject matter of claim 12, which the examiner has separately classified in Group II. The limitation in Group III (claim 16) is also in Group I (claim 3) or the limitation in Group III (claim 18) is also in Group I (claims 4-6). Therefore, the Examiner’s classifications are incorrect.

Secondly, there are some overlapping fields of search within the different groups. For example since subject matter of claim 40 is in claim 12, both subclasses 402 and 407 in class 313


must be searched.

Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Response. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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